

REMARKS

In this Amendment, Applicant has cancelled Claims 12-22, without prejudice or disclaimer, and added new Claims 23 – 44. It is respectfully submitted that no new matter has been introduced by the amended claims. All claims are now present for examination in view of the accompanying remarks.

The specification has been amended to cross reference to the prior PCT application. The amendments to the specification are entirely editorial in nature. It is respectfully submitted that no new matter has been introduced by the amended specification. Favorable reconsideration is respectfully requested in view of the preceding amendments and the following comments.

REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH:

Claims 12, 13, 18 and 20-22 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the invention was filed, had possession of the claimed invention. Applicant traverses the rejection.

It is respectfully submitted that in view of presently claimed invention, the rejection has been overcome. In particular, the new added claims 23 and 34 and their corresponding dependent claims clearly defined that “R₁ and Y₁, and/or, R₂ and Y₂ form a saturated or unsaturated heterocyclic group having 5 to 7 ring members of which at least one is oxygen or nitrogen,” which has the support from the specification (page 1, lines 25-26; page 35, compound number 18; page 37, compound number 62-64).

Accordingly, withdrawal of the rejection under 35 U.S.C. § 112 first paragraph is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH:

Claims 21 and 22 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant traverses the rejection.

It is respectfully submitted that in view of presently claimed invention, the rejection has been overcome. In particular, the new added Claims 32, 33, 43 and 44 have been written in the method claim format to more clearly and thoroughly describe the subject matter of Applicant's invention. The Board of Patent Appeals and Interferences has held that a claim which clearly recited the step of "utilizing" was not indefinite under 35 U.S.C. § 112 second paragraph. See *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992).

Accordingly, withdrawal of the rejection under 35 U.S.C. § 112 second paragraph is respectfully requested.

In addition, Claims 12 – 22 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant traverses the rejection.

It is respectfully submitted that in view of presently claimed invention, the rejection has been overcome. In particular, Applicant has rephrased certain expression, used proper Markush group format, and corrected certain clerical errors as Examiner suggested.

Please note that Applicant traverses the Examiner's rejection OF Claims 21 and 22 in the point 3 ag) on alleged "undue experimentation." The fact that experimentation

may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. subnom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed Cir. 1985). The art of drug development typically engages in complex experimentation, such as developing inhibitor for thromboxan A2 for treating an illness involving a thromboxan A2, including cardio-vascular and blood, pulmonary, reproduction and renal diseases. But these experimentations are not undue in the present application. There was a high level of skill of art at the time the application was filed and all methods needed to practice the invention were well known. It is well known in the art that a thromboxan A2 relates to cardio-vascular and blood, pulmonary, reproduction and renal diseases and an inhibitor to a thromboxan A2 provide treatment for these diseases (see specification pages 23, 25). In addition, it is not required that the Applicant demonstrate that the invention is completely safe. Applicant has provided in the specification the *in vitro* pharmacological tests that were described in literature. "All the results are recorded in parallel with those of two thromboxan A2 receptors antagonists described in literature and which are the object of in-depth clinical studies: the sulotroban and the SQ-29.548." Thus the *in vitro* animal model data correlates a known data in the art. A rigorous or an invariable exact correlation is not required, as stated in *Cross v. Lizuka*, 753 F.2d 1040, 1050 (Fed. Cir. 1985).

Accordingly, withdrawal of the rejection under 35 U.S.C. § 112 second paragraph on "undue experimentation" is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 101:

Claims 21 and 22 have been rejected under 35 U.S.C. § 101 as improper process claim. Applicant traverses the rejection.

It is respectfully submitted that in view of presently claimed invention, the rejection has been overcome. In particular, the new added Claims 32, 33, 43 and 44 have

been written in the method claim format to more clearly and thoroughly describe the subject matter of Applicant's invention.

REJECTIONS UNDER 35 U.S.C. § 102:

Claims 12, 13, 17, 18 and 20 have been rejected under 35 U.S.C. § 102 (e) as allegedly being anticipated by Muller et al. (US 6,525,211), hereinafter Muller. Claims 12, 15 and 18 have been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Schlebe et al., Journal fuer Praktische Chemie, hereinafter Schlebe. Claims 12-14, 18 and 20 has been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Wittner et al., hereinafter Wittner. Applicant traverses the rejection and respectfully submits that the present-claimed invention is not anticipated by the cited reference.

It is respectfully submitted that to satisfy the requirements of § 102, *each and every* element of a claimed invention must be found in the cited anticipative reference; it is insufficient that the corresponding element in the cited anticipative reference be "equivalent" to the element of the claimed invention. *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). It is further respectfully submitted that in order to anticipate the presently claimed invention, a reference must contain all of the essential elements in the invention as claimed. *Lewmar Marine Inc. v. Bariant Inc.*, 827 F.2d 744, 3 USPQ 1766 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). Further, a reference that merely contains substantially the same elements is insufficient to "anticipate" the claimed invention. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985).

The newly added Claims 23, 34 and corresponding defendant Claims as rejected has been amended to delete the requirement of "Y₁ represents an oxygen." Oxygen is a required element in the cited Muller and Schlebe references. Therefore, the newly presented claims are not anticipated by Muller and Schlebe.

In addition, the Examiner regards Wittner as teaching that R₁ and Y₁ represent 3-methylphenylamino, which is indeed an m-toluyamino. The Claims 23, 34 and corresponding dependant Claims as presented exclude R₁ as an m-toluyl group, which includes m-toluyamino, thus the 3-methylphenylamino in Wittner reference. Therefore, it is respectfully submitted that in view of presently claimed invention, the rejection has been overcome.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and prompt action toward that end is respectfully solicited.

Respectfully submitted,

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